

### **REMARKS/ARGUMENTS**

The present Amendment and Response comprises the Applicant's reply to the Examiner's non-final Office Action with a mailing date of November 12, 2008. Claim 2 has been canceled and Claims 3-9, 11, 13-20, 27, and 29-35 have been amended. Claims 12, 26 and 28 remain in their prior form. Accordingly, Claims 1, 3-9, 11-20 and 26-35 are currently pending.

In the latest Office Action, the Examiner withdrew the allowability of the claims and rejected all of the claims under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) citing U.S. Pat. App. Pub. No. 2004/0172044 to Grimm et al. ("Grimm '044"). The Applicant respectfully traverses the rejections.

A rejection under 35 U.S.C. § 102(e)/103(a) is only proper when the subject matter used in the rejection is: (1) in compliance with 35 U.S.C. § 112; (2) disclosed in the earlier filed application; and (3) entitled to the priority date of the earlier-filed application. See MPEP § 2136.03; see also *In re Wertheim*, 646 F.2d 527 (Fed. Cir. 1981) (denying Examiner's rejection under 35 U.S.C. § 102(e)/103(a), as subject matter of CIP application used as basis of rejection was not disclosed in parent application.) The Examiner has not met the burden of showing that Grimm '044 meets this standard to be appropriate subject matter for the basis of this rejection. To further support the traversal of this rejection, Applicant states as follows: Grimm '044 was filed on March 8, 2004. The current application has a filing date of July 21, 2003. Accordingly, Grimm '044 does not qualify as prior art that can be cited against the current application unless support for the content cited is provided in an earlier parent application. The parent application to Grimm '044 corresponds to U.S. Pat. App. Pub. No. 2004/0122305 ("Grimm '305"). Grimm '305 only contains Figs. 1-7. Accordingly, content filed in Grimm '044 that did not appear in

Grimm '305 is not available under 35 U.S.C. § 102(e) to be cited against the present application.

For this reason, the Applicant traverses the Examiner's reliance on all such content, including reference to Fig. 8 that does not appear in Grimm '305.

In addition to the foregoing, on page 3 of the Office Action the Examiner stated that “[s]tabilizing projections or pins, e.g., the screws which pass through holes 102, 104, 106, and 108, are removably positioned to extend from a bottom surface of the body.” Review of Grimm '305 indicates that no “projections” are disclosed in Grimm '305 to stabilize the body of the assembly, and it is respectfully noted that there is no support for the Examiner's assertion. The Applicant refers now to the first sentence of Paragraph [0047] of Grimm '305 that states “[i]n alternative embodiments, reference elements 114 may be permanently secured to instrument body 36 or individually removably mounted to instrument body 36 such as to bore holes 102, 104, 106 and/or 108.” Thus, Grimm '305 describes that bore holes 102, 104, 106 and 108 are for receiving the reference elements 114, and there is no teaching that something passes through the bore holes 102, 104, 106 and 108 to contact bone or tissue to stabilize the underside of the instrument body 36.

The Applicant has amended Claim 1 herein to now include the projection limitation previously found in Claim 2. Support of the amendment to Claim 1 can further be found in the present application as filed, such as in the various figures, and in the specification, such as between line 20 of page 9 and line 4 of page 10. The other independent claims already include limitations directed to the projection. Since the cited prior art fails to teach all of the claim limitations in the claims presented herein, the Examiner is respectfully requested to withdraw the 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) rejections.

Other amendments made to the dependent claims are to place the wording in conformance with that used in the independent claims from which they depend, and there has been no new matter added or narrowing of the claim content by such amendments. The Examiner is requested to contact the Applicant if the Examiner disagrees with this statement.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 12th day of February, 2009.

Respectfully submitted,

/Mark L. Yaskanin/  
Mark L. Yaskanin  
Registration No. 45,246  
Attorney for Applicant  
Holme Roberts & Owen LLP  
Customer No. 23337  
Telephone: (303) 866-0269